



Docket No.: 4635-003

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Koichiro MITSUI et al.

U.S. Patent Application No. 10/673,260

Filed: September 30, 2003

For: DISPOSABLE DIAPER

: : EXPEDITED PROCEDURE  
: : Response under 37 CFR 1.116  
: Confirmation No. 2073  
:  
: Group Art Unit: 3761  
:  
: Examiner: MELANIE D HAND

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Mail Stop AF**

COMMISSIONER FOR PATENTS

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Sir:

This paper is submitted in reply to the Final Office Action mailed *October 11, 2006*.

Applicants respectfully request review of the final rejections of claims 1-20 as manifested in the Final Office Action. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal in compliance with *37 CFR 41.31* and the fee set forth in *37 CFR 41.20(b)(1)*.

The review is requested for the reasons stated on the attached sheets.

### REASONS

The following clear errors are found in the Examiner's rejections.

1. The 35 U.S.C. 102(b) rejection of independent claim 1 as being anticipated by *Gesp* (WO 97/28774) is clearly erroneous, because the reference does not teach or disclose, and the Examiner has failed to specify with reasonable clarity how the reference might teach or disclose, the features of claim 1 that (i) “the side flaps being disposed between said top sheet and back sheet,” and (ii) “each of said side flaps comprising an elastic sheet sandwiched between upper and lower non-woven fabric layers.”

1.1. The Examiner states <sup>1</sup> that *Gesp* discloses, in Fig. 1 and page 7, lines 17-26, a pair of side flaps that extend outwardly and have longitudinal edges 22 and 24. The side flaps of *Gesp* as interpreted by the Examiner are apparently integrated with the main diaper body or assembly 12 <sup>2</sup> which includes topsheet 28 and backsheet 30. Thus, the side flaps of *Gesp* as interpreted by the Examiner should also include topsheet 28 and backsheet 30, and cannot be considered as being disposed between its own components, i.e., topsheet 28 and backsheet 30. Therefore, *Gesp* does not teach or disclose limitation (i) of independent claim 1.

1.2 The Examiner states <sup>3</sup> that *Gesp* teaches laminate assembly 10 from which the side flaps are formed. The laminate assembly 10 is disclosed by *Gesp* to include topsheet 28, backsheet 30 and core 26. <sup>4</sup> However, laminate assembly 10 is not disclosed by *Gesp* to include an elastic sheet sandwiched between two layers of non-woven fabric as presently claimed. Thus, *Gesp* does not teach or disclose limitation (ii) of independent claim 1. Applicants respectfully submit that if it is the Examiner's position that the claimed elastic sheet is obvious in view of *Gesp* and/or other references of records, the anticipatory rejection of claim 1 should be withdrawn and rephrased to reflect such position.

1.3. It should be noted that diapers embodying the structure as defined in limitations (i)

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<sup>1</sup> See Final Office Action at page 3, lines 1-2.

<sup>2</sup> See Final Office Action at page 2, line 10.

<sup>3</sup> See Final Office Action at page 2, line 10.

<sup>4</sup> See *Gesp* at page 8, lines 17-22.

and (ii) and the other features of independent claim 1 provide several advantages that are not deemed disclosed or achievable by *Gesp* and/or the prior art.<sup>5</sup> For example, the elastic sheet sandwiched between two layers of non-woven fabric renders the side flap elastically stretchable. As a result, the side flap can be easily stretched to bring the fixing tape to a desired anchoring position when the diaper is being put on a wearer,<sup>6</sup> thereby improving fit around the wearer's waistline. The applied references, especially *Gesp*, do not appear to fairly teach or suggest such easy and smooth handling.

2. Another clear error is found in the Examiner's response to Applicant's argument. The Examiner appears to argue<sup>7</sup> that although the hooks 54 are shown in all figures of *Gesp* to be spaced from the topsheet 14, they are capable of engaging the topsheet 14 when force is applied to temporarily fix the tape fastener to the side flap by adhesive 52. The Examiner further alleges<sup>8</sup> that depending on the magnitude of said force, the side flap will engage some, but not all, of hooks 54, thereby defining engaging and non-engaging regions as claimed.

Applicants respectfully traverse the Examiner's "capable of" argument as it amounts neither to the "explicit disclosure" nor "implicit disclosure" standards under the anticipatory test of 35 U.S.C. 102.<sup>9</sup>

2.1. Applicants respectfully submit that *Gesp* fails to explicitly teach the limitation of independent claim 1 that (iii) "an engaging region provided on each said side flap to engage the respective fixing tape with said side flap through the hook member, said engaging region including portions having an engaging force with said hook member that is different from an engaging force in other portions of said engaging region." As can be seen in all figures of *Gesp*, the fixing tape 32 is engaged with the "side flap" through adhesive 52, rather than hooks 54. This arrangement is similar to the known arrangement discussed in the specification, at the paragraph bridging pages 2-3, and hence, is well distinguished from the claimed invention.

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<sup>5</sup> See the specification at page 31, line 13 to page 32, the last line.

<sup>6</sup> See attached *Exhibit A*.

<sup>7</sup> See Final Office Action at page 2.

<sup>8</sup> See Final Office Action, at page 5, lines 5-7 from bottom.

<sup>9</sup> See *MPEP*, section 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added).

2.2. Applicants respectfully submit that *Gesp* fails to implicitly teach the limitation (iii) of independent claim 1, because the hooks 54 of *Gesp* do not necessarily engage with the respective “side flaps” in the presently claimed manner.<sup>10</sup>

For the reasons detailed above, Applicants respectfully submit that *Gesp* does not anticipate independent claim 1. The reference, therefore, fails to anticipate or render obvious dependent claims 2-17.

3. The 35 U.S.C. 102(b) rejection of independent claim 18 as being anticipated by *Gesp* is clearly erroneous, because the reference does not teach or disclose the features of claim 18 that “when said fixing tape is temporarily fixed to said side flap before use, said engaging portion is in direct contact and engaged with some, but not all, of the hooks of the respective hook member.”

*Gesp* does not teach or disclose the feature of claim 18, either explicitly or implicitly, for at least the reasons detailed above in sections 2.1 and 2.2. It should be noted again that the Examiner’s argument that some but not all of hooks 54 are capable of engaging the “side flaps” does not meet the inherency standard which requires the Examiner to show that the hooks necessarily so engage.

For the reason detailed above, Applicants respectfully submit that *Gesp* does not anticipate independent claim 18. The reference, therefore, fails to anticipate or render obvious dependent claims 19-20.

4. As to claim 10, a further clear error has been discussed in the Amendment filed July 13, 2006, at page 9, the last full paragraph, to which the Examiner has failed to respond.

5. As to claim 19, *Gesp* does not anticipate this claim. Claim 19, when read together with claim 18, requires that both the engaging portion and the non-engaging portion directly contact the respective hooks, and yet at different engaging forces. There is no disclosure, either explicit or implicit, in *Gesp* that hooks 54, when in direct contact (if at all) with the “side flaps,” would exhibit

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<sup>10</sup> See *MPEP*, section 2112.IV: “A basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added).

different engaging forces as presently claimed.

6. As to claim 20, the applied references, especially *Tanzer*, fails to teach or suggest that "said fixing tape substrate has an attaching portion attached to a surface of the respective side flap, said attaching portion having an opening through which a portion of said surface of said side flap is exposed to define said engaging portion." As best seen at Figs. 5-6 in *Tanzer*, it is the hooks (66), rather than the side flap as presently claimed, that are exposed through the openings. Thus, the Examiner's combination of *Tanzer* with *Gesp*, if proper, would still fail to teach or disclose at least the above discussed limitation of claim 20.

Withdrawal of the final rejections in view of the above is believed appropriate and therefore respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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# Exhibit A

